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| To: Commissioner for Patents for Examiner Charles A. Fox Group Art Unit 3652 | Facsimile No.: 703/872-9306 |
| From: Stephanie Fay Legal Assistant to Betty Formby | No. of Pages Including Cover Sheet: 6 |
| Message: Enclosed herewith: <ul style="list-style-type: none">• Transmittal Document; and• Reply Brief. | |
| Re: Application No.: 10/033,879 Attorney Docket No.: 00-073-TAP | |
| DATE: Thursday, July 07, 2005 | |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Smith et al.

Serial No.: 10/033,879

Filed: December 19, 2001

For: Online, Safe Service Technique
for Automated Libraries§
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§

Group Art Unit: 3652

Examiner: Fox, Charles A.

Attorney Docket No.: 00-073-TAP

Certificate of Transmission Under 37 C.F.R. § 1.8(a)

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By: 

Stephanie Fay

TRANSMITTAL DOCUMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

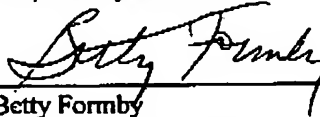
Sir:

ENCLOSED HEREWITH:

- Reply Brief (37 C.F.R. 41.41).

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to Deposit Account No. 19-4545. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Deposit Account No. 19-4545.

Respectfully submitted,



Betty Formby

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PATENT

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By:


Stephanie Fay

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on May 9, 2005.

No fees are believed to be required to file a Reply Brief. Any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

(Reply Brief Page 1 of 4)
Smith et al. - 10/033.879

ARGUMENT

In the Examiner's Answer, the Examiner states:

The appellant argues that neither the *Faiman et al.* or the *Priestly et al.* references do not teach what they are reputed to show. The appellant then argues each reference separately without regard to the admitted prior art.¹

In reply, it is noted that the office action states a rejection in which three separate pieces, e.g., *Faiman*, *Priestly*, and a prior art media library, need to fit together to create a whole. Given the whole "fabric" of the claimed invention, each of these cited pieces must "cover" the part it is cited to show or the rejection does not meet the claimed recitation. In arguing each of the references, Appellants have pointed out the parts of the invention that are attributed to, but not shown by, the cited art.

The Federal Circuit has ruled:

The mere fact that the prior art could be readily modified to arrive at the claimed invention does not render the claimed invention obvious; the prior art must suggest the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Response re Faiman

With regard to *Faiman*, the response states:

Regarding the assertion that *Faiman et al.* reference does not teach the speed being dependent upon the door setting the examiner does not agree with the appellant. Based on tables 1 and 2 supplied by the appellant in the appeals brief *Faiman et al.* are shown to teach a device that operates in two modes (higher range and slow) when a safety door is closed and only one mode (slow) when the safety door is opened.²

Appellants assert that, contrary to the Examiner's statement above, *Faiman* shows two speeds (slow and immobilized) when the safety door is opened, depending on the mode setting of the machine. In fact, it is more accurate to say that the range of speeds allowed on the machine is controlled by the mode setting, i.e., run or jog, while the actual speed of the machine is controlled by a combination of factors: the mode setting, the position of the door, and the speed that is manually entered on the speed control (see Figure 5 of *Faiman* below).

¹ Examiner's Answer of May 9, 2005, p.5, 1. 2-4

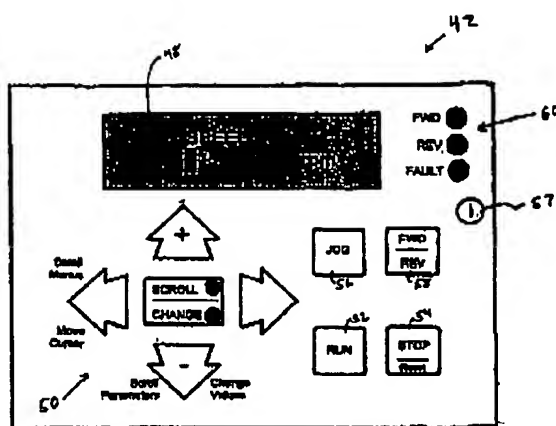


FIG 5

The rejection cites *Faiman* as showing, a control device that operates the device in the following modes: a first mode where the door is closed and the device moves at a first specified speed; a second mode where the door is open and the device moves at a second specified speed that is slower than said first specified speed. To read *Faiman*, or even *Faiman* combined with a prior art media library, on the recited limitation requires a careful picking and choosing of only those pieces of *Faiman*

that favor a reconstruction of the claimed invention, while ignoring large areas of *Faiman* that do not fit this reconstruction. Despite the Examiner's statement to the contrary, this is hindsight reconstruction.

Response re Priestly

With regard to *Priestly*, the rejection states:

The admitted prior art and *Faiman et al.* do not teach the second operating speed as being set automatically once the interlock is triggered. *Priestly et al.* US 6,405,114 teach a device with an interlock system comprising:
 a drive motor for wheels;
 interlocks for determining if a boom is in a lowered position or not;
 whereby if the boom is in the lowered position said device travels at a first speed;
 whereby if said boom is not in the lowered position said interlocks limit the speed of the device to a second speed that is non-zero and slower than said first speed. ...

The *Priestly et al.* reference is used as a teaching of two elements and how they related to each other. First, the two elements are a drive motor for wheels labeled as element (104) is taught by *Priestly et al.* and the second element an interlock limiting the speed of this drive is also taught by the reference ... The interaction of the two elements is the only source of argument in the instant

² Examiner's Answer of May 9, 2005, p.5, 1.10-15

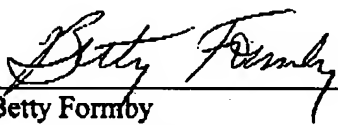
appeal.³

Notably, there is no assertion above that Priestly automatically controls the speed, rather the assertion is that the interlock in this patent limits the speed. That is, the interlock will not let the speed increase beyond a certain point, but it is not itself determining the speed. This appears to agree with the teachings of Priestly. However, this is not true of the claimed invention, which controls the speed of the robots, even when the library is being worked on.

Thus, Priestly, alone or in combination with the other references, does not meet the claimed limitation of *a control component that operates the robot in the media library in one of the following modes: if the access means is closed, a normal mode, wherein the picker robot automatically moves at a first specified speed; and if the access means is open, a safe mode, wherein the picker robot automatically moves at a second specified speed that is a non-zero speed and is slower than the first speed of the normal mode.*

It has been shown that neither Faiman nor Priestly nor the prior art media library disclose an automatic control of the speed of elements within a machine both when the machine is operating normally and when it under maintenance (e.g., an access door is open). Neither do any of these references, alone or in combination, suggest this feature.

In conclusion, it is requested that the Board of Appeals overturns the rejection of all outstanding claims in light of the arguments presented in the Appeal Brief and herein.


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³ Examiner's Answer of May 9, 2005, p.5, l. 21 through p. 6, l.5